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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,678	07/23/2003	Hikaru Sugita	5988-054-27	6692

7590 02/17/2005

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EXAMINER

LEE, RIP A

ART UNIT PAPER NUMBER

1713

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/624,678

Applicant(s)

SUGITA ET AL.

Examiner

Rip A. Lee

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 6, 7, 9, 11 and 12 is/are allowed.
- 6) ☒ Claim(s) 5 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11-22-2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action follows a response filed on November 22, 2004. Applicants have amended claims 5 and 6. Claim 10 was canceled, and new claims 11 and 12 were added.

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 5 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 6-161111 to Murata *et al.* for the same reasons set forth in the previous office action.

Breifly, Murata *et al.* discloses radiation sensitive resin compositions comprising units derived from styrene substituted with $-\text{CH}_2\text{OCOOR}$ and $-\text{CH}_2\text{OCH}_2\text{CH}_2\text{COOR}$ groups (see structures on page 4). These groups qualify as "acyl group," as recited in the present claims. Solvents are discussed in paragraph [0057], and compositions of polymer and solvent are used to cast resist films on silicon wafers (see paragraph [0059]). Use of acid generating compounds is discussed extensively on pages 8 and 9. In sum, all aspects of the present claims are taught adequately in the prior art of Murata *et al.*

Allowable Subject Matter

3. The following is a statement of reasons for the indication of allowable subject matter: Claims 1-4 and 7 are allowed, as indicated previously. Claims 6, 9, 11, and 12 are allowed over all cited references in this and previous office actions. None of the references discloses the subject matter of the present invention.

Response to Arguments

4. Applicants traverse the rejection of claims 5 and 8 as being under 35 U.S.C. 102(b) as being anticipated by JP 6-161111 to Murata *et al.* Applicant's arguments have been considered fully, but they are not persuasive. As elucidated in paragraph 2 of this office action, the embodiments shown in the prior art contain "acyl groups," as recited in the present claims. Therefore, the subject matter of the present claims is still anticipated by the reference. Consequently, the rejection has not been withdrawn.

Information Disclosure Statement

5. The information disclosure statement filed November 11, 2003 has been entered into the record.

Prior Art

6. EP 1 205 805 (corresponding US-PG publication 2002/0086934) to Kawaguchi *et al.* has been cited in a foreign search report as an "X" reference. The patent discloses polymers derived from acenaphthylene derivatives in which substituent R¹ is hydrogen, alkyl, alkenyl, hydroxyl, amino, phenyl, acyl, carboxyl, sulfonic acid, mercapto, *etc.* The reference does not disclose or reasonably suggest use of ROCH₂- groups.

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Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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February 14, 2005



DAVID W. WU
SUPERVISORY PATENT EXAMINER
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